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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,735	07/08/2003	Yasco Wainberg		1821

7590 12/27/2004
Stephen E. Feldman, P.C.
12 East 41st Street
New York, NY 10017

EXAMINER
HO, THOMAS Y

ART UNIT	PAPER NUMBER
3677	

DATE MAILED: 12/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/615,735	WAINBERG, YASCO	
	Examiner	Art Unit	
	Thomas Y Ho	3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 7 and 9-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>07082003</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-6 and 8, drawn to a ring, classified in class 63, subclass 15.
- II. Claims 7 and 9-12, drawn to a process of making a ring, classified in class 29, subclass 29/8.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case invention I can be made by a multitude of other processes, including but not limited to engraving, cutting, hole-forming, metal deformation, texturing, or any combination thereof.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Stephen Feldman on 12/15/04 a provisional election was made with traverse to prosecute the invention of the ring, claims 1-6 and 8.

Affirmation of this election must be made by applicant in replying to this Office action. Claims 7, 9, and 10-12 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moldenhauer US1936604 in view of Pappert US1778726.

As to claim 1, Moldenhauer discloses: a ring: a first band portion 2 having an inner surface and an outer surface a second band portion 1 having an inner surface and an outer surface and a plurality of engravings in said first portion. The difference between the claim and Moldenhauer is the claim recites: a plurality of openings extending from the inner surface to the outer surface. Pappert discloses a ring having two band portions, similar to that of Moldenhauer. In addition, Pappert further teaches that the first band 10 has engraving, or equivalently, piercing (P. 1, Ln. 38-48). It would have been obvious to one of ordinary skill in the art, having the disclosures of Moldenhauer and Pappert before him at the time the invention was made, to modify the first band portion of Moldenhauer to have pierced designs extending from the inner surface to the outer surface, as in Pappert. One would have been motivated to make such a combination because the ability to form a pleasing open work design would have been achieved, as taught by Pappert (P. 1, Ln. 40-45). The limitation of being "cast" is a method step in an apparatus claim that holds little patentable weight.

As to claim 2, Pappert teaches: said openings form indicia or geometric designs.

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As to claim 3, Moldenhauer discloses: the first portion has an outer surface which is the same diameter as the inner surface of the second portion.

As to claim 4, Moldenhauer discloses: the first portion fits inside the second portion to form a single ring.

As to claim 5, Moldenhauer discloses: the inner surface of the second portion is flat (P. 3, Ln. 15-20) and forms the back surface of the openings of indicia or designs in the first portion.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moldenhauer US1936604 in view of Pappert US1778726, and further in view of case law.

As to claim 6, the difference between the claim and Moldenhauer is the claim recites: the first portion and the second portion are of different precious metals and are cast separately and fitted together. The selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). It is old and well known that rings can be made of any of a number of precious metals.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moldenhauer US1936604 in view of Pappert US1778726, and further in view of Baum US5916271.

As to claim 8, the difference between the claim and Moldenhauer is the claim recites: wherein the first and second portions are cast from wax by the lost wax process. This is a method step in an apparatus claim that holds little patentable weight. Nevertheless, Baum discloses a jewelry ornament similar to that of Moldenhauer. In addition, Baum further teaches that lost wax casting (and several other processes; Col. 4, Ln. 20-31) are commonly employed. It would have been obvious to one of ordinary skill in the art, having the disclosures of

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Moldenhauer and Baum before him at the time the invention was made, to modify the ring of Moldenhauer to be made by lost wax casting, as in Baum. One would have been motivated to make such a combination because the ability to produce a desired shape would have been achieved, and because it is old and well known in the art to use such processes.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1. US1712417 to Beaujard discloses a ring.
2. US1999974 to Heyman discloses a wedding ring.
3. US5228316 to Meyrowitz discloses a ring with replaceable members.
4. US5483808 to Barbazza discloses an annular structure meant for pieces of real jewelry and cheap jewelry.
5. US6295732 to Ofiesh discloses a method of manufacturing jewelry.
6. US6526779 to Foote discloses a ring identification system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas Y Ho whose telephone number is (703)305-4556. The examiner can normally be reached on M-F 10:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J Swann can be reached on (703)306-4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

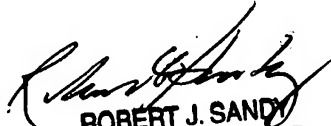
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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TYH


ROBERT J. SANDY
PRIMARY EXAMINER